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**Rejection of Claims 1-18 Under
Section 102(e) Based Upon Zelman**

In the Office Action, the pending claims in this application, i.e., claims 1-18, have been rejected under 35 U.S.C. § 102(e) (hereinafter "Section 102(e)") as being anticipated by U.S. Patent No. 6,343,858 to Zelman (hereinafter "Zelman").

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of anticipation under Section 102(e), the rejection is misplaced, and it should be withdrawn. The Office Action fails to articulate and establish that the Zelman document alone discloses the invention as claimed, including each and every limitation of the claim.¹ Moreover, as set forth below, Zelman indeed fails to fully disclose the invention as claimed.

Claims 1-9

The present invention as recited in pending independent claim 1 is not anticipated by Zelman, and therefore the rejection is misplaced and should be withdrawn, because Zelman fails to disclose an eyewear assembly as recited in claim 1, wherein the eyewear assembly comprises, in combination and among other limitations, primary eyeglasses comprising a frame including first and second recessed sockets, each provided with respective metallic, non-magnetized bottom

¹ It is fundamental law that a reference, to anticipate a claim under Section 102(e), must fully disclose the invention as claimed, and thus each limitation of the claimed invention must be identically disclosed in the reference. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 U.S.P.Q.2d (BNA) 1299 (Fed. Cir. 2000). Given that no specific explanation is provided in the Office Action for

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and side walls, and auxiliary eyeglasses comprising a bridge, first and second auxiliary lens rims, and first and second arms, wherein the first and second arms each have a respective magnet permanently affixed to them, and further wherein the magnets have protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets, as recited in claim 1.

Zelman merely discloses an auxiliary eyewear attachment apparatus wherein eyeglass frame appendages and auxiliary eyeglasses each contain magnet pairs, e.g., magnets 26 and "complementary magnets" 30. (See, e.g., Zelman, col. 5, lines 45-52.) Zelman fails to disclose or teach the eyewear assembly as recited in claim 1, for example, because Zelman fails to disclose or teach primary eyeglasses comprising, inter alia, first and second recessed sockets having metallic, non-magnetized bottom and side walls, as recited in claim 1.

Zelman also fails to render the eyewear assembly of claim 1 obvious, for example, because Zelman further fails to provide the necessary suggestion or motivation to a person of ordinary skill in the art to make the substantial modifications and extensions of the auxiliary eyewear attachment apparatus disclosed in it to obtain the invention of claim 1. Applicant finds nothing in Zelman, for example, that suggests one should remove the "complimentary" magnets.

the rejection of the claims with respect to Zelman, Applicant reserves the right to supplement the discussion of the claims should a more specific basis for their rejection be provided.

Indeed, Zelman teaches away from the invention of claim 1 by specifically teaching that complimentary magnet pairs should be used to aid in alignment.

In view of the foregoing, Applicant respectfully submits that the rejection of claim 1 under Section 102(e) is misplaced, and requests that it be withdrawn.

Claims 2-9 are not anticipated by Zelman, and patentably distinguish over it, for example, in that they depend from and more specifically recite the invention of independent claim 1.

Claims 10-18

Zelman also fails to anticipate independent claim 10 of the present application because Zelman fails to disclose an eyewear assembly as recited in claim 10, wherein the eyewear assembly comprises, in combination and among other limitations, primary eyeglasses comprising a frame including first and second magnets, and auxiliary eyeglasses comprising a bridge, first and second auxiliary lens rims, and first and second arms, wherein each of the first and second arms have a recessed socket, and wherein each of the sockets is provided with a metallic, non-magnetized bottom and side walls, and wherein the magnets have protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets, as recited in claim 10.

As pointed out above, Zelman merely discloses an auxiliary eyewear attachment apparatus wherein eyeglass frame appendages and auxiliary eyeglasses

each contain magnet pairs, e.g., magnets 26 and "complementary magnets" 30. Zelman fails to disclose or teach the eyewear assembly as recited in claim 10, for example, because Zelman fails to disclose or teach primary eyeglasses comprising, inter alia, first and second magnets, and an auxiliary eyeglass having a frame with first and second arms, each of which comprises first and second recessed sockets having metallic, non-magnetized bottom and side walls, as fully recited in claim 10.

Zelman also fails to render the eyewear assembly of claim 10 obvious, for example, because Zelman further fails to provide the necessary suggestion or motivation to a person of ordinary skill in the art to make the substantial modifications and extensions of the auxiliary eyewear attachment apparatus it discloses to obtain the invention of claim 10. Again, Applicant finds nothing in Zelman that suggests one should remove one of the paired magnets. As noted, Zelman teaches away from the invention of claim 10 by specifically teaching that complimentary magnet pairs should be used to aid in alignment.

In view of the foregoing, Applicant respectfully submits that the rejection of claim 10 under Section 102(e) is misplaced, and also requests that it be withdrawn.

Claims 11-18 are not anticipated by Zelman, and patentably distinguish over it, for example, in that they depend from and more specifically recite the invention of independent claim 10.

Conclusion

In view of the foregoing, Applicant submits that the pending claims are allowable and that the application is in condition for allowance. Reconsideration of

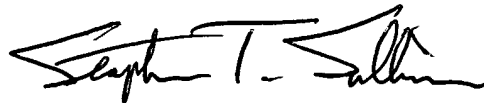
the application in view of this Response and its passage to issue are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule such interview.

This Response is being filed within three months of the date of the Office Action. Accordingly, a petition for extension of time and petition fee are not being concurrently filed. If any fees are due in connection with the filing of this Response, please charge our Deposit Account No. 501324 and accept this paper as a petition for extension.

Dated: June 18, 2002

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen T. Sullivan". The signature is stylized with a large, sweeping initial 'S' and a distinct 'T'.

Stephen T. Sullivan
Reg. No. 32,444

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Date of Deposit June 18, 2002

I hereby certify that this Response to Office Action No. 1 is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed Assistant Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C. 20231.

Lisa Mansur